

REMARKS

Claims 1-6, 8, 10-15 and 21-42 are pending in this application. Claims 1 and 15 have been amended so as to clarify the scope of the claimed method of treatment and address the issue under 35 U.S.C. 112 discussed in detail below.

Interview Conducted May 17, 2005

A personal Interview was conducted on May 17, 2005. The Interview Summary record states in connection with this Interview that, "Applicant discussed amendments and the difference between treatment of osteoporosis and hyperparathyroidism. The Examiner will consider the rejection of record based on said amendment(s) and applicant's argument."

During the Interview, the Examiner pointed out that the precise wording of the proviso in claim 1 that "... said osteoporosis and related bone conditions are not caused by hyperparathyroidism, ..." was not actually fully supported by the present specification, since the present specification does not specifically address any causal connection between osteoporosis and hyperparathyroidism. In response to this issue, claim 1 has been amended so as to simply recite that the method of treatment excludes hyperparathyroidism.

Removal of Previous Basis for Rejection Under 35 U.S.C. 112

The Final Office Action of February 11, 2005, indicated that various claims were rejected under 35 U.S.C. 112, first paragraph, because of the proviso previously recited in claim 1 and removed in the presently amended form of claim 1. Thus, the basis for this rejection has been removed and it is requested that the rejection not be reinstated.

Basis for Allowability of Claims

The previous Final Office Action indicated that the previous rejections under 35 U.S.C. 102 and 103 based on prior art had been withdrawn. It is submitted that these rejections should not be reinstated. In summary, the prior art discloses compounds which are disclosed to be useful for treating hyperparathyroidism. However, the prior art fails to disclose or suggest anywhere the use of the compounds recited in the present claims for treating osteoporosis or related bone conditions with the exclusion of hyperparathyroidism. Further, the previously submitted declaration evidence has established in the record that the disease state of hyperparathyroidism is significantly different from the disease state of osteoporosis. Hyperparathyroidism, as well as the resulting disease state of osteomalacia, are treated by the suppression of parathyroid hormone, wherein as in contrast, osteoporosis is treated by changing the balance between anabolic and catabolic processes in the bone, e.g. by inhibiting bone resorption.

In addition to the above, it is submitted that claim 24 is specifically directed to the "treatment of osteoporosis" as an alternative to claim 21 which includes related bone conditions.

Request for Personal Interview

Applicant's representative respectfully requests another personal Interview with the Examiner. It appears that most or all of the issues in connection with this application have been resolved, such that if a Notice of Allowance does not issue, then a personal Interview could likely resolve any outstanding issues. The Examiner will be contacted in about one month in order to schedule the Interview. In any case, it is requested that the Examiner not issue any Office Action before the Interview, if an Interview is necessary.

Application No.: 09/787,548

Docket No.: 3893-0112P

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

Dated: June 13, 2005

Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant